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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/568,944

02/22/2006

Tadashi Yoneda

Q77281

8590

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

GUPTA, ANISH

ART UNIT

PAPER NUMBER

1654

NOTIFICATION DATE

DELIVERY MODE

09/27/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

sughrue@sughrue.com  
PPROCESSING@SUGHRUE.COM  
USPTO@SUGHRUE.COM

<b>Office Action Summary</b>	<b>Application No.</b> 10/568,944	<b>Applicant(s)</b> YONEDA, TADASHI	
	<b>Examiner</b> ANISH GUPTA	<b>Art Unit</b> 1654	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                     |                                                                   |
|-------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                         | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/29/09 has been entered.

### ***Election/Restrictions***

2. Applicant's election of the species of a peptide of formula (I) wherein R is an isoalkyl group having 11 carbon atoms and X is a leucine in the reply filed on August 20, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

A search was conducted for the elected species. During the course of the search, prior art was found that disclosed the genus of claim 3. Accordingly, the all of the species taught in the prior art that read on the genus of claim 3 have been applied. The election of species IS NOT vacated however. This is because, while the prior art applied may disclose some members of the genus, the prior art does not disclose all of the members that belong the genus of "lipopeptide compound" as claimed in claim 1. Thus, the election of species is maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 1-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Yoneda et al. (WO99/62482) in view of Noda (JP07-304630) for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to cosmetic composition comprising a lipopeptide and a polyoxyethylene glyceryl ether fatty acid ester.

Yoneda et al. teaches cosmetic formulations comprising a lipopeptide that has low skin penetration and low skin irritation (see abstract). Specifically, the reference discloses a lipopeptide having a sequence corresponding to Formula I as claimed in claim 3 (see page 5 and 6 of the reference). The reference states that the lipopeptide has the effect of inhibiting the skin penetration of a skin irritating substance and reduces the irritation of a skin irritating substance such as a paraben compound (see page 6-7). The reference discloses the weight of the lipopeptide in an amount between .01 to 30% by weight (see page 7). The reference discloses that external cosmetic include skin milk, skin cream, foundation cream, massaging cream, cleansing cream, shaving cream, lotion, shampoo, hair tonic, hair dye (see page 14). The reference discloses a milky lotion that contains as one of the agents within the composition Avocado oil (see page 59). The difference

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between the prior art and the instant claims is that the reference does not specifically teach the use of polyoxyethylene glyceryl fatty acid.

However, Noda et al. teach that conventional cosmetics contain oils require two steps of washing since the oil utilized in the makeup is not readily removed (see page 3 of translation). The reference states that this can be avoided if the cosmetic composition contains polyoxyethylene glyceryl fatty acid ester (see page 4 of translation). When this is used, not only does the composition work as a cosmetic but also provides a foaming action that allows for the removal of the makeup in a single step fashion. The reference states that the composition containing the fatty acid ester has a high cleaning effect and has an excellent usability and feel (see page 10). The reference states that fatty acid ester can be either isostearic acid or oleic acid (See page 5). The composition can contain 1-80% of in the total weight of the composition (see page 5). The reference discloses that other agents can be added to the cosmetic such as polyhydric alcohol, propylene glycol, oil, paraffin, uv ray absorbent (see page 5). It would have been obvious, therefore, to use polyoxyethylene glyceryl fatty acid ester in the cosmetic formulation of Yoneda because polyoxyethylene glyceryl fatty acid ester provides a composition that allows with a high cleaning effect and has an excellent usability and feel. The presence of polyoxyethylene glyceryl fatty removes the need to of a two step washing procedure to remove the makeup and avoid residual oil. There would have been reasonable expectation because Noda et al. teaches the presence of polyoxyethylene glyceryl fatty acid ester in cosmetic formulations such as lip stick, foundation, mascara etc. . . and Yoneda discloses the similar cosmetic formulations. Note that Yoneda discloses the presence of oil and wax in some of the cosmetic preparations. Thus, the claims are rendered obvious over the prior art.

With respect to the concentration ranges claimed, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless

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there is evidence indicating such concentration or temperature is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See MPEP 2144.05. Here, the prior art disclose concentration ranges for the agent utilized. Thus, it would have been obvious to optimize and improve upon what is already generally known to find the optimum combination of percentages.

### **Response to Arguments**

Applicants argue that neither Yoneda nor Noda disclose or suggest that using only polyoxyethylene glyceryl fatty acid ester achieves a positive result. Applicants make reference to table 1 of the Noda reference and state that "Noda shows that sample 1, in which only polyoxyethylene(20)glyceryl triisostearate is used as a surfactant, was inferior in foaming property and freshen up feeling. In contrast, sample 2 to 5 illustrate that foaming property and freshen-up feeling were obtained by combining maltitol hydroxydodecyl ether with the surfactant." Applicants again assert that the declaration submitted by Tadashi Yoneda demonstrates that balance between good washability and preservation stability cannot be achieved if polyoxyethylene sorbitan fatty acid ester is used in place of polyoxyethylene glyceryl ether fatty acid ester.

Applicants arguments have been fully considered but have not been found persuasive.

It is assumed that Applicants are arguing that the reference does not teach the use of using only polyoxyethylene glyceryl fatty acid ester because the claims have been amended to recite the transitional phrase "consisting of." Presumably, the claims now exclude the addition of maltitol taught in Noda et al. However, even with this phrase, the claims do not exclude the use of maltitol

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hydroxydodecyl ether. This is because the claim has been amended to recite “an optionally at least one ingredient selected from the group consisting of . . .” The claim then recites numerous agents that can be added to the lipopeptide and the glyceryl fatty acid ester. The disclosure of maltitol ether falls within the genus of saccharides or a surfactant. Thus, the mere fact that the instant claims recite “consisting of” language does not result in the exclusion of maltitol ether of the prior art.

Assuming *arguendo* that the amendment of adding the transitional phrase excludes the maltitol ether, the reference, as Applicants have pointed out in table 2, still teaches the use of polyoxyethylene(20)glyceryl triisostearate alone. The reference still states that the addition of polyoxyethylene(20)glyceryl triisostearate alone was excellent in removal of makeup (see page 14). It would have been obvious, therefore, to use polyoxyethylene glyceryl fatty acid ester in the cosmetic formulation of Yoneda because polyoxyethylene glyceryl fatty acid ester provides a composition that allows with a high cleaning effect.

While it is acknowledged, that the reference also states that the addition of maltitol ether resulted in formability and tendency for admiration, the comparison was only made with respect to polyoxyethylene(20)glyceryl triisostearate alone. This does not demonstrate a teaching that polyoxyethylene(20)glyceryl triisostearate alone should not be used. The comparison made was within the reference of polyoxyethylene(20)glyceryl triisostearate alone and polyoxyethylene(20)glyceryl triisostearate alone and maltitol ether. The comparison never mentioned nor compared the result to the composition of Yoneda alone and Yoneda with polyoxyethylene(20)glyceryl triisostearate. Thus any conclusions made with respect to the combination of polyoxyethylene(20)glyceryl triisostearate alone and maltitol ether cannot be attributed to the use polyoxyethylene(20)glyceryl triisostearate alone in Yoneda. That is, one could not and would not conclude that polyoxyethylene(20)glyceryl triisostearate alone used in Yoneda

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would not have better cleansing and excellent usability and feel. To the contrary, since the polyoxyethylene(20)glyceryl triisostearate alone was excellent in removal of makeup, one would expect at the very least polyoxyethylene glycerly fatty in the cosmetic formulation of Yoneda would have a high cleaning effect. Thus, there is still motivation to combine. Furthermore, the MPEP states “[a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” Here, the mere fact that Noda may teach that polyoxyethylene(20)glyceryl triisostearate alone was somewhat less inferior to that combination of polyoxyethylene(20)glyceryl triisostearate alone and maltitol does not render a composition with polyoxyethylene(20)glyceryl triisostearate alone patentable.

Finally, with respect to the Declaratoin, as stated in the previous office action, the Declaration provide by Applicants do not clearly establish unexpected results. The declaration states that Yoneda formulation separated into two layers and exhibited markedly poor preservation stability. Preservation was based solely on changes observed. However "observation" does not provide an object means of demonstrating stability. It is unclear how the separation of the Yoneda product implies or establishes poor preservation stability.

Secondly, the Declaration does not demonstrate why one would not expect separation to occur when the teachings of Noda are applied. That is the rejection is premised on modify the formulation of Yoneda with Noda. The Declaration does not clearly establish that one would have also expected a separation when Noda's teachings were applied to Yoneda.

Rejection is maintained.



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2. Claims 1-15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sakai et al. (JP2000136114) in view of Yoneda et al. for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to cosmetic composition comprising a lipopeptide and a polyoxyethylene glyceryl ether fatty acid ester.

Saka et al. teaches cleansing cosmetic formulations that contain that drops the charge of face make up with high water resisting property (see page 2). The reference disclose formulations containg N-acyl glutamic acid diester as the active agent in the composition. The reference also states that in the cleansing formulation other agents such as bees wax, jojoba oil, non ionic surface agent such as polyoxyethylene fatty acid esters, and multivalent alcohol ester antiseptics can be used (see page 5). Specifically, the reference discloses a water-in-oil cleansing cream formulation that contains paraffin 40%wt, hydrogenated tallow 2 %wt, sorbitan sesquioleate 1.4 %, polyoxyethylene stearate 1.5 %, polyoxyethylene glyceryl isostearate 1.3 %, behenyl alc. 1 %, paraben 0.5 %, Eldew CL 202 (N-lauroylglutamic acid cholesteryl octyldodecyl ester) 5 %, 1,3-butanediol 3 %, glycerin 2.5 %, and H<sub>2</sub>O 41.8% (see abstract and example 1 on page 5). Note that the formulation contains polyoxyethylene glyceryl isostearate, which is the polyoxyethylene fatty acid ester and paraben. The difference between the prior art and the instant application is that the reference does not teach the use of a lipopeptide as claimed.

However, Yoneda et al. teaches cosmetic formulations comprising a lipopetide that has low skin penetration and low skin irritation (see abstract). Specifically, the reference disclose a lipopeptide having a sequence corresponding to Formula I as claimed in claim 3 (see page 5 and 6 of the reference). The reference states that the lipopeptide has a the effect of inhibiting the skin penetration of a skin irritating substance and reduces the irritation of a skin irritating substance such

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as a paraben compound (see page 6-7). The reference disclose the weight of the lipopeptide in an amount between .01 to 30% by weight (see page 7). The reference discloses that external cosmetic include skin milk, skin cream, foundation cream, massaging cream, cleansing cream, shaving cream, lotion, shampoo, hair tonic, hair dye (see page 14). It would have been obvious, therefore, to formulate the composition of Sakai et al. with the lipopeptide of Yoneda because the presence of lipopeptide has a the effect of inhibiting the skin penetration of a skin irritating substance and reduces the irritation of a skin irritating substance such as a paraben compound. Note that Sakai et al. teaches a specific formulation with paraben. There would have been a reasonable expectation of success because Yoneda et al. teaches that the lipopeptide can be formulated into cosmetic cleaning compositions. Thus, the claims are rendered obvious.

With respect to the concentration ranges claimed, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See MPEP 2144.05. Here, the prior art disclose concentration ranges for the agent utilized. Thus, it would have been obvious to optimize and improve upon what is already generally known to find the optimum combination of percentages.

### **Response to Arguments**

Applicants argue that Sakai contains N-acyl glutamic acid diester as a essential ingredient. Applicants state that cosmetic composition of “claim 1 does not contain N-acyl glutamic acid

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diester” since it “recites the transitional phrase ‘consisting of’ which excludes any element, step, or ingredient not specified in the claim.” Applicants also argue the inferiority results within the reference of Sakai when N-lauroyl glutamic acid was not utilized.

Applicants arguments have been fully considered but have not been found persuasive.

First, even though the claims utilize the transitional phrase "consisting of" the claims do not exclude the addition of N-acyl glutamic acid diester. This is because the claim has been amended to recite “an optionally at least one ingredient selected from the group consisting of . . .” The claim then recites numerous agents that can be added to the lipopeptide and the glyceryl fatty acid ester. N-acyl glutamic acid diester falls within the genus of the claimed additional agents. Attention is directed to page 12 of the specification where it is taught that anionic surfactant include:

“sodium stearyl glutamate, coconut oil fatty acid acyl glutamic acid, potassium coconut oil fatty acid acyl glutamate, sodium coconut oil fatty acid acyl glutamate, coconut oil fatty acid acyl glutamate triethanolamine, lauroylacyl glutamic acid, potassium lauroylacyl glutamate, sodium lauroylacyl glutamate, lauroylacyl glutamate triethanolamine, myristoylacyl glutamic acid, potassium myristoylacyl glutamate, sodium myristoylacyl glutamate, stearylacyl glutamic acid, potassium stearylacyl glutamate, disodium stearylacyl glutamate, sodium hydrogenated beef tallow fatty acid acyl glutamate, sodium coconut oil fatty acid/hydrogenated beef tallow fatty acid acyl glutamate. . .”

The instant specification also states that that the following can also be added:

“esters such as isopropyl myristate, butyl myristate, isopropyl palmitate, ethyl stearate, butyl stearate, ethyl oleate, ethyl linoleate, isopropyl linoleate, cetyl caprylate, hexyl laurate, isooctyl myristate, decyl myristate, myristyl myristate, cetyl myristate, octadecyl myristate, cetyl palmitate, stearyl stearate, decyl oleate, oleyl oleate, cetyl ricinoleate, isostearyl laurate, isotridecyl myristate, isocetyl myristate, isostearyl myristate, octyldodecyl myristate, 2-ethylhexyl palmitate, isocetyl palmitate, isostearyl palmitate, 2-ethylhexyl stearate, isocetyl stearate, isodecyl oleate, octyldodecyl oleate, octyldodecyl ricinoleate, ethyl isostearate, isopropyl isostearate, cetyl 2-ethylhexanoate, cetostearyl 2-ethylhexanoate, stearyl 2-ethylhexanoate, hexyl isostearate, ethylene glycol dioctanoate, ethylene glycol dioleate, propylene glycol dicaprylate, propylene glycol dicaprylate/dicaprate, propylene glycol dicaprate, propylene glycol dioleate, neopentyl glycol dicaprate, neopentyl glycol dioctanoate, glyceryl tricaprylate, glyceryl tri 2-ethyl hexanoate, glyceryl tricaprylate/tricaprate, glyceryl tricaprylate/tricaprate/tristearate, glyceryl triundecylate, glyceryl triisopalmitate, glyceryl

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triisostearate, trimethylolpropane tri 2-ethylhexanoate, trimethylolpropane triisostearate, pentaerythrityl tetra 2-ethylhexanoate, pentaerythrityl tetramyristate, pentaerythrityl tetraisostearate, diglyceryl tetraisostearate, octyldodecyl neopentanoate, isocetyl octanoate, isostearyl octanoate, 2-ethylhexyl isopelargonate, hexyldodecyl dimethyloctanoate, octyldodecyl dimethyloctanoate, 2-ethylhexyl isopalmitate, isocetyl isostearate, isostearyl isostearate, octyldodecyl isostearate, lauryl lactate, myristyl lactate, cetyl lactate, octyldodecyl lactate, triethyl citrate, acetyltriethyl citrate, acetyltributyl citrate, trioctyl citrate, triisocetyl citrate, trioctyldodecyl citrate, diisostearyl malate, 2-ethylhexyl hydroxystearate, di 2-ethylhexyl succinate, diisopropyl adipate, diisobutyl adipate, dioctyl adipate, diheptylundecyl adipate, sebacate diethyl, diisopropyl sebacate, dioctyl sebacate, cholesteryl stearate, cholesteryl isostearate, cholesteryl hydroxystearate, cholesteryl oleate, dihydrocholesteryl oleate,

Thus, the specification teaches that any acyl glutamic acid agent can be utilized as a surfactant and any ester can be utilized. The claim states that "optionally at least one ingredient selected from the group consisting of . . . esters" can be added. Given the breadth of the additional optional agents recited in the specification and the fact that the claim is open to the addition of any ester, the claims are inclusive of N-acyl glutamic acid diester taught in the prior art.

Rejection is maintained.

3. Claims 1-6, 8, 10, 12 and 14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al. (JP09-165320) in view of Yoneda et al. for the reasons set forth in the previous office action and the reasons set forth below.

The claims are drawn to cosmetic composition comprising a lipopeptide and a polyoxyethylene glyceryl ether fatty acid ester.

Ito et al. teaches cleansing cosmetic formulation in the form of a hair rinse agent composition which has a high rinsing effect and excellent in feel (see abstract). Specifically, the reference discloses a composition that contains lauryltrimethylammonium chloride, stearyltrimethylammonium chloride, cetanol, polyoxyethylene sorbitan tetraoleate, sorbitan

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monooleate, glycerin monocaprylate, liq. paraffin, perfume, and paraben (see abstract and pages 7-8). Note that the formulation contains polyoxyethylene sorbitan tetroleate, which is the polyoxyethylene sorbit fatty acid ester and paraben. The reference exemplifies formulation where the concentration of the fatty acid ester is 2.5% by weight (see page 7). The difference between the prior art and the instant application is that the reference does not teach the use of a lipopeptide as claimed.

However, Yoneda et al. teaches cosmetic formulations comprising a lipopeptide that has low skin penetration and low skin irritation (see abstract). Specifically, the reference disclose a lipopeptide having a sequence corresponding to Formula I as claimed in claim 3 (see page 5 and 6 of the reference). The reference states that the lipopeptide has a the effect of inhibiting the skin penetration of a skin irritating substance and reduces the irritation of a skin irritating substance such as a paraben compound (see page 6-7). The reference disclose the weight of the lipopeptide in an amount between .01 to 30% by weight (see page 7). The reference discloses that external cosmetic include skin milk, skin cream, foundation cream, massaging cream, cleansing cream, shaving cream, lotion, shampoo, hair tonic, hair dye (see page 14). It would have been obvious, therefore, to formulate the composition of Sakai et al. with the lipopeptide of Yoneda because the presence of lipopeptide has a the effect of inhibiting the skin penetration of a skin irritating substance and reduces the irritation of a skin irritating substance such as a paraben compound. Note that Ito et al. teaches a specific formulation with paraben. There would have been a reasonable expectation of success because Yoneda et al. teaches that the lipopeptide can be formulated into shampoos and hair tonic compositions. Thus, the claims are rendered obvious.

With respect to the concentration ranges claimed, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. Where the general

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conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. The normal desire of scientists or artisans to improve upon what is already generally known provides the motivation to determine where in a disclosed set of percentage ranges is the optimum combination of percentages. See MPEP 2144.05. Here, the prior art disclose concentration ranges for the agent utilized. Thus, it would have been obvious to optimize and improve upon what is already generally known to find the optimum combination of percentages.

### **Response to Arguments**

Applicants argue that neither reference teaches polyoxyethylene glyceryl fatty acid ester. Applicants state that the reference of Ito does not have "high rinsing effect." Applicants state that the condition composition of the prior art is used to replenish oil content to hair and make hair supple after washing. Applicants state that this is completely different from a cleansing composition.

Applicants arguments have been fully considered but have not been found persuasive.

Applicants state that the composition of the prior art is not a "cleansing" composition. In response to applicant's arguments, the recitation cleansing composition has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

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Furthermore, assuming *arguendo*, cleansing composition is given weight, the body of the claims sets forth the components of the composition. Here, these components are taught by the prior art. Thus, since the reference discloses the recited agents within the claim, the reference discloses the composition and the cleansing action is necessarily present within the composition.

Applicants state neither reference teaches polyoxyethylene glyceryl fatty acid ester. However, the Ito reference discloses polyoxyethylene sorbitan tetroate (see above). The reference teaches that the HLB value should be between 8-13 (see page 3 of the reference). On page 6 of the instant specification, it is taught that examples of the polyoxyethylene glyceryl ether fatty acid ester include polyoxyethylene (30) sorbit tetraoleate. This has an HLB value between 8-13. Thus, the reference teaches polyoxyethylene glyceryl fatty acid ester.

Note that while Ito teaches other agents, these are not excluded from the claims since many are cited within the instant specification as cationic surfactant, non ionic surfactant, etc... In essence, all of the agents recited fall within the large genus of agents permitted as additional agent within the claim.

The rejection is maintained.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Gupta whose telephone number is (571)272-0965. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can normally be reached on (571) 272-0562. The fax phone number of this group is (571)-273-8300.

/Anish Gupta/  
Primary Examiner, Art Unit 1654

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